
To: Pramac America, LLC (masteiner@duanemorris.com)
Subject: U.S. TRADEMARK APPLICATION NO. 85226865 - POWERMATE - R1755-POWERM
Sent: 6/29/12 4:44:17 PM
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Attachments:

**UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)
OFFICE ACTION (OFFICIAL LETTER) ABOUT APPLICANT'S TRADEMARK APPLICATION**

APPLICATION SERIAL NO. 85226865

MARK: POWERMATE

85226865

CORRESPONDENT ADDRESS:

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APPLICANT: Pramac America, LLC

**CORRESPONDENT'S REFERENCE/DOCKET
NO:**

R1755-POWERM

CORRESPONDENT E-MAIL ADDRESS:
masteiner@duanemorris.com

OFFICE ACTION

STRICT DEADLINE TO RESPOND TO THIS LETTER

TO AVOID ABANDONMENT OF APPLICANT'S TRADEMARK APPLICATION, THE USPTO MUST RECEIVE APPLICANT'S COMPLETE RESPONSE TO THIS LETTER **WITHIN 6 MONTHS** OF THE ISSUE/MAILING DATE BELOW.

ISSUE/MAILING DATE: 6/29/2012

THIS IS A SUBSEQUENT FINAL ACTION.

This Office action is in response to applicant's communication filed on May 11, 2012. Applicant's communication is hereinafter referenced as: "Response".

The previous Final Office Action of November 13, 2011, and all supporting evidence attached thereto, is incorporated by reference herein.

After review of the Response, the following is determined:

- the refusal to register on the ground of likelihood of confusion as to the marks in U.S. Registration Nos. 3886843 and 2010643 is **MAINTAINED** and **CONTINUED**;
- the refusal to register on the ground of likelihood of confusion as to the marks in U.S. Registration Nos. 0698071 and 2514977 is **OBVIATED** by applicant's amendment to the identification of goods;
- the proposed amendment to the identification of goods in International Class 007 is **ACCEPTED** and will be **ENTERED INTO THE RECORD**; and
- the proposed claim of ownership of prior registration is **ACCEPTED** and will be **ENTERED INTO THE RECORD**.

FINALITY OF REFUSAL MAINTAINED AND CONTINUED

For the reasons set forth below, the refusal under Trademark Act Section 2(d) is now made FINAL with respect to U.S. Registration No(s). 3886843 and 2010643. *See* 15 U.S.C. §1052(d); 37 C.F.R. §2.64(a).

SECTION 2(d) LIKELIHOOD OF CONFUSION REFUSAL

Registration of the applied-for mark is refused because of a likelihood of confusion with the marks in U.S. Registration Nos. 3886843 and 2010643. Trademark Act Section 2(d), 15 U.S.C. §1052(d); *see* TMEP §§1207.01 *et seq.* See the previously enclosed registrations.

I. 2(d) STANDARD OF REVIEW

Trademark Act Section 2(d) bars registration of an applied-for mark that so resembles a registered mark that it is likely that a potential consumer would be confused or mistaken or deceived as to the source of the goods and/or services of the applicant and registrant. *See* 15 U.S.C. §1052(d). The court in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973) listed the principal factors to be considered when determining whether there is a likelihood of confusion under Section 2(d). *See* TMEP §1207.01. However, not all the factors are necessarily relevant or of equal weight, and any one factor may be dominant in a given case, depending upon the evidence of record. *Citigroup Inc. v. Capital City Bank Grp., Inc.*, 637 F.3d 1344, 1355, 98 USPQ2d 1253, 1260 (Fed. Cir. 2011); *In re Majestic Distilling Co.*, 315 F.3d 1311, 1315, 65 USPQ2d 1201, 1204 (Fed. Cir. 2003); *see In re E. I. du Pont*, 476 F.2d at 1361-62, 177 USPQ at 567.

In this case, the following factors are the most relevant: similarity of the marks, similarity of the goods and/or services, and similarity of trade channels of the goods and/or services. *See In re Dakin's Miniatures Inc.*, 59 USPQ2d 1593 (TTAB 1999); TMEP §§1207.01 *et seq.*

II. APPLICATION OF THE 2(d) STANDARD OF REVIEW

The cited registrations are marks for the following goods:

- Registration No. 3886843, POWERMATE for "Lubricating oils for use with machinery"; "Nozzles for air sanders; regulators for use with air tools; hose connectors and couplers for use with air tools; grinding stones for use with air tools; spray guns, caulking guns; sand blasters; combination filter, regulator and lubricator for use with air tools; chisels for use with air hammers; socket sets for use with air tools; portable air tanks for use with air tools"; and "air hoses"; and
- Registration No. 2010643, POWERMATE for "air compressors, air ratchet wrenches, air hammers, air impact wrenches, air drills, air sanders, air grease guns, air tire inflators, air wheel cutters, air

grinders, and air engine cleaning guns” and “emergency and portable lights, battery powered lights and security lighting”.

Registration Nos. 3886843 and 2010643 share common ownership.

A. COMPARISON OF SOUND, APPEARANCE AND MEANING

In a likelihood of confusion determination, the marks are compared for similarities in their appearance, sound, meaning or connotation, and commercial impression. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973); TMEP §1207.01(b)-(b)(v). Similarity in any one of these elements may be sufficient to find the marks confusingly similar. *In re White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB 1988); see *In re 1st USA Realty Prof'ls, Inc.*, 84 USPQ2d 1581, 1586 (TTAB 2007); TMEP §1207.01(b).

The cited registered marks are: POWERMATE.

The applied for mark features the wording POWERMATE.

Applicant's mark is identical to the cited registered marks, thus the marks have the same meaning and create the same commercial impression, such that consumers would be likely to confuse the source of goods offered under this mark.

B. COMPARISON OF GOODS

The goods and/or services of the parties need not be identical or directly competitive to find a likelihood of confusion. See *Safety-Kleen Corp. v. Dresser Indus., Inc.*, 518 F.2d 1399, 1404, 186 USPQ 476, 480 (C.C.P.A. 1975); TMEP §1207.01(a)(i). Rather, it is sufficient to show that because of the conditions surrounding their marketing, or because they are otherwise related in some manner, the goods and/or services would be encountered by the same consumers under circumstances such that offering the goods and/or services under confusingly similar marks would lead to the mistaken belief that they come from, or are in some way associated with, the same source. *In re Iolo Techs., LLC*, 95 USPQ2d 1498, 1499 (TTAB 2010); see *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 1566-68, 223 USPQ 1289, 1290 (Fed. Cir. 1984); TMEP §1207.01(a)(i).

The goods identified in the cited registered marks include:

- air-powered tools and accessories for air-powered tools (Registration Nos. 3886843 and 2010643);
- air compressors; portable lights and battery-powered lights (Registration No. 2010643).

The goods identified in the application, as amended, are for:

- “Corded and cordless power tools, namely, drills, sanders, circular saws”;
- “Portable, battery powered jump-start systems for automotive and marine use, comprised of a rechargeable battery, cables, charging cords, power ports and rechargeable work light; Stand-alone portable AC/DC power inverters”; and
- “Portable, battery powered work lights”.

Consumers are likely to confuse the source of the goods for the applied for mark and cited registrations because the goods of the applied for mark and the cited registrations are at a minimum, related, and could be overlapping.

Specifically, applicant's power tools ("drills, sanders, circular saws") are related to registrant's air-powered tools and accessories for air-powered tools (Registration Nos. 3886843 and 2010643) as applicant's tools may encompass and/or be highly-related to registrant's tools (including: "air drills, "air sanders").

Applicant's battery-powered work lights are related to registrant's portable lights and battery-powered lights (Registration No. 2010643) as registrant's goods encompass applicant's goods.

Furthermore, as the goods of the applied for mark and the cited registrations are related and possibly overlapping, they may travel within the same channels of trade.

The trademark examining attorney has previously attached evidence from the USPTO's X-Search database consisting of a number of third-party marks registered for use in connection with the same or similar goods as those of both applicant and registrant in this case. This evidence shows that the goods and/or services listed therein, namely, drills, sanders and/or circular saws and air tools, are of a kind that may emanate from a single source under a single mark. *See In re Davey Prods. Pty Ltd.*, 92 USPQ2d 1198, 1203 (TTAB 2009); *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785-86 (TTAB 1993); *In re Mucky Duck Mustard Co.*, 6 USPQ2d 1467, 1470 n.6 (TTAB 1988); TMEP §1207.01(d)(iii).

C. SUMMARY OF 2(d) REVIEW

The applied for mark is confusingly similar to the cited registered marks because the marks are identical. Because the marks are confusingly similar and because the goods are related and/or travel within the same channels of trade, the applicant's mark is refused on grounds of likelihood of confusion.

Although applicant's mark has been refused registration, applicant may respond to the refusal(s) by submitting evidence and arguments in support of registration.

Applicant's arguments have been considered and found unpersuasive for the reason(s) set forth below.

Applicant states that cited Registration Nos. 2010643 (POWERMATE) and 3886843 (POWERMATE) were assigned by applicant or a related entity to the current registrants and that the Trademark Assignment and License Agreement, for which applicant provided two pages as evidence, "allows for and consents to Applicant's registration of the POWERMATE mark for the goods, as amended, in the subject application". The assignment and license agreement pages do not indicate that the assignee has given any consent to the use and registration of the applied-for goods in the present application. Therefore, the assignment and license do not overcome the refusal to register the applied for mark under Section 2(d) as to cited Registration Nos. 2010643 and 3886843 is FINAL.

Applicant argues that marks containing the terms "POWER" and "MATE" are entitled to only a narrow scope of protection in Classes 007 and 009 due to the coexistence of multiple marks featuring this wording. Regardless of the numbers of marks in these classes that may feature these terms, the cited registered marks are identical marks for highly related goods with those of applicant, and as such are likely to cause consumer confusion as to the source of goods appearing under the POWERMATE mark.

Applicant argues that purchasers of its goods are sophisticated purchasers unlikely to confuse the source of its goods with those of others. The fact that purchasers are sophisticated or knowledgeable in a particular field does not necessarily mean that they are sophisticated or knowledgeable in the field of trademarks or immune from source confusion. TMEP §1207.01(d)(vii); *see In re Cynosure, Inc.*, 90 USPQ2d 1644 (TTAB 2009); *In re Decombe*, 9 USPQ2d 1812 (TTAB 1988); *In re Pellerin Milnor Corp.*,

221 USPQ 558 (TTAB 1983).

The overriding concern is not only to prevent buyer confusion as to the source of the goods and/or services, but to protect the registrant from adverse commercial impact due to use of a similar mark by a newcomer. *See In re Shell Oil Co.*, 992 F.2d 1204, 1208, 26 USPQ2d 1687, 1690 (Fed. Cir. 1993). Therefore, any doubt regarding a likelihood of confusion determination is resolved in favor of the registrant. TMEP §1207.01(d)(i); *see Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 1265, 62 USPQ2d 1001, 1003 (Fed. Cir. 2002); *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 464-65, 6 USPQ2d 1025, 1025 (Fed. Cir. 1988).

For the above stated reasons, the Trademark Act Section 2(d) refusal is FINAL.

Although applicant's mark has been refused registration, applicant may respond to the refusal(s) by submitting evidence and arguments in support of registration.

RESPONSE TO FINAL ACTION

If applicant does not respond within six months of the date of issuance of this final Office action, the application will be abandoned. 15 U.S.C. §1062(b); 37 C.F.R. §2.65(a). Applicant may respond to this final Office action by:

- (1) Submitting a response that fully satisfies all outstanding requirements, if feasible; and/or
- (2) Filing an appeal to the Trademark Trial and Appeal Board, with an appeal fee of \$100 per class.

37 C.F.R. §§2.6(a)(18), 2.64(a); TBMP ch. 1200; TMEP §714.04.

In certain rare circumstances, a petition to the Director may be filed pursuant to 37 C.F.R. §2.63(b)(2) to review a final Office action that is limited to procedural issues. 37 C.F.R. §2.64(a); TMEP §714.04; *see* 37 C.F.R. §2.146(b); TBMP §1201.05; TMEP §1704 (explaining petitionable matters). The petition fee is \$100. 37 C.F.R. §2.6(a)(15).

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TO RESPOND TO THIS LETTER: Go to http://www.uspto.gov/trademarks/teas/response_forms.jsp. Please wait 48-72 hours from the issue/ mailing date before using TEAS, to allow for necessary system updates of the application. For *technical* assistance with online forms, e-mail TEAS@uspto.gov. For questions about the Office action itself, please contact the assigned trademark examining attorney. **E-mail communications will not be accepted as responses to Office actions; therefore, do not respond to this Office action by e-mail.**

All informal e-mail communications relevant to this application will be placed in the official application record.

WHO MUST SIGN THE RESPONSE: It must be personally signed by an individual applicant or someone with legal authority to bind an applicant (i.e., a corporate officer, a general partner, all joint applicants). If an applicant is represented by an attorney, the attorney must sign the response.

PERIODICALLY CHECK THE STATUS OF THE APPLICATION: To ensure that applicant does not miss crucial deadlines or official notices, check the status of the application every three to four months using Trademark Applications and Registrations Retrieval (TARR) at <http://tarr.uspto.gov/>. Please keep a copy of the complete TARR screen. If TARR shows no change for more than six months, call 1-800-786-9199. For more information on checking status, see <http://www.uspto.gov/trademarks/process/status/>.

TO UPDATE CORRESPONDENCE/E-MAIL ADDRESS: Use the TEAS form at <http://www.uspto.gov/teas/eTEASpageE.htm>.

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**IMPORTANT NOTICE REGARDING YOUR
U.S. TRADEMARK APPLICATION**

**USPTO OFFICE ACTION HAS ISSUED ON 6/29/2012 FOR
SERIAL NO. 85226865**

Please follow the instructions below to continue the prosecution of your application:

TO READ OFFICE ACTION: Click on this [link](http://portal.uspto.gov/external/portal/tow) or go to <http://portal.uspto.gov/external/portal/tow> and enter the application serial number to access the Office action.

PLEASE NOTE: The Office action may not be immediately available but will be viewable within 24 hours of this e-mail notification.

RESPONSE IS REQUIRED: You should carefully review the Office action to determine (1) how to respond; and (2) the applicable response time period. Your response deadline will be calculated from 6/29/2012 (or sooner if specified in the office action).

Do NOT hit "Reply" to this e-mail notification, or otherwise attempt to e-mail your response, as the USPTO does NOT accept e-mailed responses. Instead, the USPTO recommends that you respond online using the Trademark Electronic Application System Response Form.

HELP: For *technical* assistance in accessing the Office action, please e-mail TDR@uspto.gov. Please contact the assigned examining attorney with questions about the Office action.

WARNING

Failure to file the required response by the applicable deadline will result in the ABANDONMENT of your application.